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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,019	01/11/2002	Jean-Francois Courtoy	78200-040	5197

7590 04/23/2004

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EXAMINER	
VO, HAI	

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/046,019	COURTOY ET AL.	
	Examiner	Art Unit	
	Hai Vo	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-58* is/are pending in the application.

4a) Of the above claim(s) *1-30 and 37-45* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *31, 32, 34-36, 46, 48, 49, 53, and 55* is/are rejected.

7)☒ Claim(s) *33,47,50-52,54 and 56-58* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 April 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 31, 32, 35, 46, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Courtoy et al (Re 33, 599) in view of Baskin (US 4,877,656). It is noted that the second ink and the third ink are not required by the claims and therefore any limitations associated with them are completely excluded from the claims. Courtoy teaches a synthetic covering comprising a substrate, a foamed plastic layer overlaying the substrate, a first ink 3 containing an expansion inhibitor and an UV initiator on the foam layer (column 7, lines 13-15). Courtoy further discloses that the synthetic covering comprises an additional ink 4 containing the UV initiator on the foam layer (column 7, lines18-20). Courtoy teaches a cured layer overlaying the foam layer and first ink wherein the portion of the cured layer disposed over the first ink 3 is mechanically embossed with a graining roll. Courtoy does not specifically disclose the mechanically embossed texture having relatively deep embossed depths as compared with a matting grain. Baskin teaches a method of fabricating simulated stone surfaces having relatively deep emboss depths on the substrate to provide the surface covering with a texture finish (abstract, figure 2B). This is important to the expectation of successfully practicing the invention of Courtoy and thus suggesting the

modification. Therefore, it would have been obvious to one having ordinary skill at the time the invention was made to substitute the artificial high gloss stone for the grained appearance for the cured layer overlaying the foamed plastic layer and ink motivated by desire to provide the surface covering with a texture finish.

The art rejections over Courtoy in view of Baskin have been maintained for the following reasons. Applicant argues that the Baskin reference has nothing to do with mechanical embossing. The examiner disagrees since Baskin teaches a method of fabricating simulated stone surfaces having relatively deep embossed depths on the substrate to provide the surface covering with a texture finish (abstract, figure 2B). Baskin clearly teaches mechanical embossing. Applicant further argues that the embossing of Baskin is applied to the entire surface of the substrate, which is substantially different from the present invention, the first embossed texture in register with an ink containing a photoinitiator printed in a design. The arguments are not found persuasive for patentability. The teaching of the Baskin reference would give those skilled artisans the tools necessary to conclude that substitution of the simulated stone surfaces having relatively deep embossed depths for the matting grain on the cured coating provides the surface covering with a texture finish. There is no need for the Baskin reference to teach a mechanism for preparing an in register embossed surface of the type described in the claims because such was already taught in the Courtoy reference. It appears that Courtoy is using the same approach to form the synthetic covering as Applicant. The portions of the cure

coating which overlie the inks containing inhibitors are in the raised areas while the portions which do not overlie the inks have smoothed out (in the depressed areas). The combination of Courtoy and Baskin would clearly arrive at the Applicant's claimed product. Accordingly, the art rejections are thus sustained.

3. Claims 34, 36, 53 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Courtoy et al (Re 33, 599) in view of Baskin (US 4,877,656), as applied to claims 31, 32, 35 and 49 above, further in view of further in view of Haemer et al (US 4,298,646) substantially as set forth in the 11/25/03 Office Action for the same reasons discussed in the paragraph no. 2 above. Applicant argues that Haemer has to do with differential gloss products which have a grained appearance completely different from texture of Applicant's claims. The arguments are not found persuasive since the teaching of the Haemer invention would give the skilled artisans the tools necessary to conclude that adding top coat on the surface of the wear layer is necessary to provide the surface covering more resistant to changes under future conditions, which is important to the expectation of successfully practicing the invention of Courtoy. There is no need for Haemer to address the texture as recited in the claims since such has been taught in the Baskin reference. Accordingly, the art rejections are thus sustained.
4. Claims 31, 32, 34-36, 46, 48, 49, 53, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al (US 6,555,216) in view of Courtoy et al (Re 33, 599). Chen teaches a surface covering comprising a substrate, a foam layer, a design layer printed with a foaming inhibitor, a wear layer and a urethane

top coat layer. Chen teaches a wear layer being provided on top of the design layer and mechanically embossed to form a mechanically embossed portion with a surface texture selected from the group consisting of wood, stone, marble, granite and brick (column 3, lines 10-30). Chen discloses the wear layer being chemically embossed (figures10). Chen discloses the design layer being formed by a non-retarder ink composition (column 13, lines 35-36). Chen discloses the design layer in the form of one or more joint or grout lines between each stone, marble or brick (column 10, lines 45-55). Likewise, it is clearly apparent that the design layers containing one or more non-retarder ink compositions. Chen does not specifically disclose the non-retarder ink composition containing a photoinitiator. Courtoy, however, teaches a surface covering for use in floor covering comprising an ink layer containing a UV initiator on the foam layer to initiate the polymerization by radiation (column 7, lines18-20). This is important to the expectation of successfully practicing the invention of Courtoy and thus suggesting the modification. Therefore, it would have been obvious to one having ordinary skill at the time the invention was made to employ the photoinitiator in the design layer motivated by the desire to initiate the polymerization by radiation.

The art rejections over Chen in view of Courtoy have been maintained for the following reasons. Applicant argues that Chen does not teach or suggest the portion of the cured coating disposed over the ink is chemically embossed and mechanically embossed with a first mechanically embossed texture. The

examiner disagrees. Chen discloses that the portion of the wear layer disposed over the ink containing the inhibitor is both chemically embossed and mechanically embossed (column 3, lines 21-30). Further, the arguments that the mechanical embossing of Chen is in the raised portions of the surface and it can not be in depressed portions because Chen mechanically embossed after the product has been chemically embossed are not found persuasive. It appears that the mechanical embossing is applied to **the entire surface of the wear layer** after the product has been chemically embossed (column 3, lines 20-30). Therefore, it is not seen that the mechanical embossing is absent in depressed portions as argued by Applicant. The product of Chen/Courtoy meets all the structural limitations as required by the claims. The surface covering comprises the backing, the foam layer, the ink with photoinitiator, the wear layer with the portions disposed over the ink is both chemically embossed and mechanically embossed. Applicant argues that the teachings of Courtoy can not overcome these deficiencies of Chen because the two inventions are based upon completely different processes which result in products having entirely different characteristics. The arguments are not found persuasive. It is noted that the claims are directed to the products and none of processing steps disclosed in the Courtoy invention has been relied on for the art rejections. The teachings of Courtoy would give the skilled artisans the tools necessary to conclude that it is obvious to use a photoinitiator in the ink composition to trigger the polymerization by radiation. Accordingly, the art rejections are thus sustained.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

   A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

   Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 31, 32, 35, 46, 48 and 49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40 of U.S. Patent No. Re 33,599 in view of Baskin (US 4,877,656). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons as set forth in the paragraph no. 2, which are believed to be pertinent.

7. The 112 claim rejections/claim objections have been overcome by the present amendment.

Allowable Subject Matter

8. Claims 33, 47, 50-52, 54, and 56-58 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. None of the prior art taken alone or in combination teaches or suggests the surface

covering as defined in the claims wherein the portion of the cured coating which is not disposed over the ink is mechanically embossed with a second mechanically embossed texture different from the first mechanically embossed texture. It is noted that the second mechanically embossed texture has relatively deep emboss depths such as natural looking texture of stone, wood, etc... as described at page 16 of Applicant's specification.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hai Vo

HV